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Paper No.

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MAY 17 2004

OFFICE OF PETITIONS

In re Application of Kara Webster, Roger Seiver and John Hawkins Application No. 10/667,143 Filed: September 19, 2003 Attorney Docket No. 2737.DHE.NP Title: Trailer Hitch Guide

DECISION REFUSING STATUS UNDER 37 C.F.R. § 1.47(a)

This is a decision on the "PETITION TO ACCEPT DECLARATION WITH MISSING INVENTOR," filed February 17, 2004 (Certificate of Mailing February 12, 2004).

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)," and should only address the deficiencies noted below, except that the reply <u>may</u> include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application**. Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on September 19, 2003, without an executed oath or declaration (and missing the statutory basic filing fee). Accordingly, on December 12, 2003, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring submission of an executed oath or declaration and payment of the surcharge for late filing under § 1.16(e) (and payment of the statutory basic filing fee). This Notice set a two month period for reply, with extensions of time obtainable under § 1.136(a).

In response, rule 47 applicants timely filed the instant petition, along with payment of the petition fee, and late surcharge (and the basic filing fee for a small entity). On petition, applicants assert that status under § 1.47(a) is proper because inventor Hawkins has failed to return the signature documents for the application, despite repeated requests from Applicants' counsel.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (2).

Petitioner has shown that after being presented with the application papers through his attorney, inventor Hawkins has, by his conduct in not responding, refused to join the application. The petition includes the petition fee and a statement of the last known address of inventor Hawkins.

However, to be acceptable under § 1.47(a) a declaration must be executed by the signing joint inventors on behalf of themselves and on behalf of the nonsigning joint inventor. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) <u>All</u> the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (<u>see MPEP \$602</u>, \$605.01, and \$1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.

(Emphasis added).

The declaration received on petition does not identify John Hawkins as a joint inventor. Thus, it cannot be considered signed by the available joint inventors on behalf of themselves and on behalf of the nonsigning joint inventor.

Further, the 2 page declaration received in the Office with the petition is not in compliance with 37 CFR 1.63 and 1.64. The declaration(s) does not identify all inventors by name, residence/post office address, and citizenship, including nonsigning inventor Hawkins.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 By FAX:

(703) 872-9306 ATTN: NANCY JOHNSON SENIOR PETITIONS ATTORNEY

By hand:

CUSTOMER SERVICE WINDOW 2011 South Clark Place Crystal Plaza Two Lobby Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at $(703)\ 305-0309$.

Petitions Attorney of Petitions